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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,077	02/10/1999	DAVID J. LADD	1298/0E486	8370

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EXAMINER

SALAD, ABDULLAHI ELMI

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 09/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/248,077

Applicant(s)

LADD, DAVID J.

Examiner

Salad E Abdullahi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-16,27-30 and 35-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-16,27-30 and 35-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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Response

1. The response filed on 06/13/2002 has been entered and made of record.
2. Applicant's arguments with regard to claims 12-16, 27-30 and 35-58 have been fully considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12-15 and 27-29, 35-41, 42-47, 49-53 and 55-57, are rejected under 35 U.S.C. 103(a) as being unpatentable over Behr et al U.S. Patent No. 5,543,789, in view of Klein et al U.S. Patent No. 5,943,398.

As per claims 12 and 27, Behr et al discloses a system for communicating with a wireless information device comprising the steps:

- receiving an information request (route guidance or route direction), (see fig. 1, the abstract and col. 5, line 66 to col. 6, line 13);
receiving a device identification from a wireless device (to receive a response to the information request a device identification would have been obviously included with the information request). For example it would have been obvious the remote unit

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(pager 20) to provide the base unit a device identification which should receive response to the information request (see also col. 12, lines 24-37).

- accessing an informational database with the information request (see fig. 1, element 72);
- receiving from the informational database text format information in response to the request (see abstract);

Behr et al does not explicitly disclose:

processing the text format with text-to-voice processor to generate an audio representation to the responsive information and sending the audio representation in a voice mailbox.

Klein et al, discloses a Messaging system, including a translation facility (101) that provides subscriber services such as voice-to-text or text-to-voice translation. The audio representation generated by the translation facility is further transmitted or stored in a subscriber voice mailbox (see fig. 2, element 101 and col. 3, lines 4-22 and col. 4, lines 11-47). Furthermore, Klein et al discloses the translation facility (101) is separate or independent from the Messaging system and is interfaced with the Messaging system (100) through the medium (102) such as the Internet. This indicates the translation facility can as well be easily incorporated with Behr et al system such that mobile or portable users of Behr system who wish to receive their information in audio format can provided with such service. In addition, Behr et al., teaches the format of the query message and the response message, may be modified to request different types of information from the map database or to specify different formats (i.e. audio) or subsets of information to be conveyed to the mobile unit. Therefore, it would have been obvious to one having ordinary skill

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in the art at the time of the invention presented with teaching of Klein et al to modify Behr et al to include the translation facility as taught by Klein et al., in order to enable the users of the system to retrieve their messages in an audio format at a later time at the their convenience.

- In considering 13-14, Behr et al discloses a system, wherein the information request contains plurality of geographic locations and the responsive information comprises driving direction between locations (see col. 3, line 51-67).
- In considering claims 15 and 40-41, Behr et al discloses a system, wherein the driving directions are provided in text or graphic format (see col. 3, line 51-67).
- in considering claims 28 and 29, Behr et al discloses a system, wherein the receiver comprises a computer server (see col. 3, line 46 and col. 4, lines 6-20).
- In considering claim 35, Klein et al., discloses recording the audio message in the mailbox for later retrieval (see 4, lines 17-47).
- As per claims 36, 44, 49 and 55. The claims recite limitations analogous to those limitation recited in claims 12 and 27, further reciting: receiving a voice call from a person desiring information (see Klein et al., col. 3, lines 12-22, where it is disclosed the translation facility includes an agent (i.e. computer or human) which can receive voice calls from the mobile units).
- In considering claims 37, 45, 50-51 and 56, Behr et al discloses the first information or the query includes an identifier which uniquely identifies the portable device (see col. 12, lines 24-36).

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- In considering claims 38-39 and 46-47, 52-53 and 57, Behr et al further discloses the query or the first information includes routing information (see col. 11, lines 5-12).
- in considering claim 43, Behr et al., further discloses the step of accessing the informational database occurs over a dedicated line(see fig.1).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 16, 30, 42, 48, 54 and 58, are rejected under 35 U.S.C. 103(a) as being unpatentable over Behr et al U. S. Patent No. 5,543,789, and Klein et al U.S. Patent No. 5,943,398 as applied to claims 12 and 27 above, and further in view of Imielinski et al U.S. Patent No. 6,240,448.

As per claims 16, 30, 42, 48, 54 and 58, Behr et al., and Klein et al discloses substantial features of the claimed invention including accessing the informational database from remote terminals through variety communications network.

Behr et al and Klein et al., is silent the communications network through which the informational database is accessed includes Internet and is accessed through HTTP emulation.

Nonetheless, accessing an informational database or business directory or map database through the Internet is well known in the art as evidenced by Imielinski et al. Imielinski et al discloses a

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system, for accessing an informational database over a network, in particular the Internet obviously HTTP emulation (see col. 1, lines 9-30, and col. 2, lines 16-44). Therefore, it would have been obvious to one having ordinary skill in the art provided with the teaching of Imielinski et al to modify Behr et al, by employing an Internet as means of communication between remote unit and base unit (Messaging system) as taught by Imielinski et al, because Internet is especially advantageous, cost effective and user friendly communication means for retrieving data.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

CONCLUSION

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8. The prior art made of record and relied upon is considered pertinent to the applicants disclosure.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Abdullahi E. Salad** whose telephone number is **(703) 308-8441**. The examiner can normally be reached on Monday to Friday from **8:30 AM to 5:00 PM**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervise, Glen Burgess, can be reached at **(703)305-4792**. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is **(703)305-3900**.

Any response to this action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 746-7238, (after final communications)

(703) 746-7239, (Official communications)

(703) 746-7240, (Non-Official/Draft).

As

9/6/2002



Dung C. Dinh
Primary Examiner